



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Nolan, et al. Art Unit: 8790
Application No.: 09/974,882 Examiner: Sita S. Pappu
Filed: October 10, 2001
Title: FACS ASSISTED METHODS FOR INTRODUCING INDIVIDUAL CHROMOSOMES INTO CELLS (as amended)

Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed May 20, 2002, please consider the following remarks.

The Examiner has set forth six (6) groups of claims as allegedly drawn to distinct inventions. The claims are grouped as follows:

Group I, claims 1-16 drawn to a method for the delivery of at least one chromosome into eukaryotic cell using a laser light pulse and confirmation by FACS, classified in class 435, subclass 460;

CERTIFICATION UNDER 37 CFR §1.8	
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, July 15, 2002 , in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.	
Cecilia Tobin (Name of Person Mailing Paper)	
<i>Cecilia Tobin</i> July 15, 2002 (Signature) (Date)	

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Group II, claim 17, drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using a laser light pulse, and a FACS means for confirming, classified in class 435, subclass 285.1;

Group III, claims 18-19, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using a linear accelerator and confirmation by FACS, classified in class 435, subclass 459;

Group IV, claim 20 drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using a linear accelerator, and a FACS means for confirming, classified in class 435, subclass 285.3;

Group V, claims 21, 24, 25, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using an electric pulse and confirmation by FACS, classified in class 435, subclass 461; and

Group VI, claim 23, drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using en electric pulse, and a FACS means for confirming, classified in class 435, subclass 285.2.

Applicants elect, with traverse, the Group V claims (claims 21, 24, 25, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using an electric pulse and confirmation by FACS) in order to be fully responsive to the Requirement for Restriction. Applicants identify claims 21, 22, 24 and 25 as reading on the method for delivery of the Group V claims.

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However, Applicants traverse the restriction requirement and respectfully request rejoinder of Group V and Group VI. Group VI is closely related to Group V. Applicants respectfully disagree with the Examiner's assertion in support of the division of Group V and Group VI that "the apparatus is a combination of apparatus for performing each of the steps of inserting and confirming separately. Additionally, a chromosome could be inserted using ultrasonic means or chemical means" (Office Action, page 3). The Group V claims require "application of an electric pulse to the cell." Similarly, the Group VI apparatus, as defined by claim 23, requires an electric field source for application of "an electric pulse" to the cell to cause fusion of the encapsulated chromosome and the cell. Thus, whether a chromosome could be inserted using ultrasonic means or chemical means is irrelevant to the consideration of whether the Group V claims could be practiced a materially different means because neither ultrasonic means nor chemical means applies an electric pulse to the cell so as to cause fusion of the chromosome and cell.

Therefore, Applicants respectfully submit that the same art would have to be searched for consideration of the Group V methods and the Group VI apparatus. Accordingly, reconsideration of the Restriction Requirement, at least to the extent of allowing rejoinder of Group V and Group VI, is respectfully requested.

Respectfully submitted,



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